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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/712,398	11/14/2000	Scott C. Harris	BIODONGLE/SCH	8991
23844	7590	09/20/2004	EXAMINER	
SCOTT C HARRIS P O BOX 927649 SAN DIEGO, CA 92192			MAHMOUDI, HASSAN	
			ART UNIT	PAPER NUMBER
			2175	

DATE MAILED: 09/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/712,398	Applicant(s) HARRIS, SCOTT C.	
	Examiner Tony Mahmoudi	Art Unit 2175	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-14 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-14 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Remarks

1. In response to communications filed on 24-May-2004, claims 1-2 and 15-20 have been canceled and claims 3, 6, and 7 are amended per applicant's request. Therefore, claims 3-14 and 21 are presently pending in the application.

Claim Objections

2. Claims 3-6 and 21 are objected to because of the following informalities.

In claim 3, line 16; "an crypted" needs to be changed to --an encrypted--.

Appropriate correction is required.

Claims 4-6 are objected to because they are dependents from the objected to independent claim 3. Appropriate corrections are required.

Claim 21 is objected to because it is a dependent from a canceled dependent claim. Claim 21 currently depends on claim 19, which has been canceled by the applicant. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 21 recites the limitation "instructions as in claim 19" in line 1. There is insufficient antecedent basis for this limitation in the claim, since claim 19 has been cancelled per applicant's request. Appropriate correction is required.

Claim 21 further recites the limitation "the specified way" in line 1, and recites the limitation "said program" in line 3. There is insufficient antecedent basis for these limitations in the claim. For the purpose of examining the case, the examiner is making the assumption that claim 21 was also meant to be cancelled by the applicant. Appropriate corrections are required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claim 7 is rejected under 35 U.S.C. 102(e) as being anticipated by Applebaum (U.S. Publication No. 2002/0044655.)

As to claim 7, Applebaum teaches a method (see Abstract), comprising:

storing encrypted information associated with a computer program (see paragraph 0009, where “storing encrypted information” is read on “encryption methods using symmetric and asymmetric keys provide a mechanism for securing data stored on the information appliance”, and see paragraphs 0040-0041, where “computer program” is read on “application”. Also see paragraphs 0034 and 0042, where it is taught that “the entire information file” is “encrypted” and “stored” within the information appliance);

obtaining personal information as part of a startup sequence for the computer program (see Abstract, and see paragraphs 0052 and 0056); and

reading the encrypted information (see figure 8), decrypting information contained therein to obtain decrypted information (see paragraph 0022), and comparing the personal information with the decrypted information (see paragraph 0052, and see page 9, claim 42);

allowing the computer program to run normally only if the personal information agrees with the decrypted information in a specified way (see pages 8-9, claim 36, where “allowing the computer program to run normally” is read on “allowing access to the distributed productivity environment”); and

further comprising allowing the software to run in a limited exception mode without establishing that the personal information agrees with the decrypted information (see pages 8-9, claim 36.)

7. Claims 8-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Brody (U.S. Publication No. 2001/0051928.)

As to claim 8, Brody teaches a method (see Abstract), comprising:

requesting a computer system to install a specified computer program (see figure 3, and see paragraphs 0063 and 0082);

determining whether the computer program is verified for installation (see paragraph 0023);

obtaining a reference biometric information from an authorized user (see paragraph 0094) at the time of installing the software (see Abstract), responsive to the determining that the computer program is verified for installation (see paragraphs 0006, 0082, and 0092); and

thereafter allowing the program to run normally only when biometric information is obtained which matches the reference biometric information (see paragraph 0153.)

As to claim 9, Brody teaches the determining comprises determining if a specified license used for the installation has already been used for another installation (see paragraphs 0023, and 0058-0060.)

As to claim 10, Brody teaches wherein the determining uses a specified unique code that was distributed with the program, and determines from a server whether the unique code has already been used for an installation (see paragraphs 0010, 0015, 0019, and 183.)

As to claim 11, Brody teaches the method further comprising, after determining that the installation is authorized, sending the reference biometric information to a server (see paragraph 0098.)

As to claim 12, Brody teaches the method further comprising, at the server, encrypting the reference biometric information (see paragraph 0152), and returning encrypted biometric reference information which is stored with the program, and which is used by the allowing (see page 23, claim 9, where “biometric reference information” is read on “personalization” and “stored within the program” is read on “within the information stream”.)

As to claim 13, Brody teaches wherein the allowing retrieves encrypted biometric information (see page 23, claim 9), decrypts the biometric information (see paragraph

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152), and allows the program to run normally only if the decrypted biometric information matches a currently entered biometric information (see paragraph 0153.)

As to claim 14, Brody teaches wherein the reference biometric information is encrypted at the server using a private key of a public key-private key pair, and the reference biometric information is decrypted when software is to be run, using the public key corresponding to the private key (see paragraph 0152.)

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applebaum (U.S. Publication No. 2002/0044655) in view of Brody (U.S. Publication No. 2001/0051928.)

As to claim 3, Applebaum teaches a method (see Abstract), comprising:
storing encrypted information associated with a computer program (see paragraph 0009, where "storing encrypted information" is read on "encryption methods using symmetric and asymmetric keys provide a mechanism for securing data stored on the information appliance", and see paragraphs 0040-0041, where "computer program" is

read on “application”. Also see paragraphs 0034 and 0042, where it is taught that “the entire information file” is “encrypted” and “stored” within the information appliance);

obtaining personal information as part of a startup sequence for the computer program (see Abstract, and see paragraphs 0052 and 0056); and

reading the encrypted information (see figure 8), decrypting information contained therein to obtain decrypted information (see paragraph 0022), and comparing the personal information with the decrypted information (see paragraph 0052, and see page 9, claim 42);

allowing the computer program to run normally only if the personal information agrees with the decrypted information in a specified way (see pages 8-9, claim 36, where “allowing the computer program to run normally” is read on “allowing access to the distributed productivity environment”);

wherein the personal information is biometric information (see Abstract), and the comparing comprises comparing the biometric information with other biometric information in the encrypted information (see paragraph 0052); and

encrypting the biometric code at the server (see paragraph 0009) and returning an encrypted sequence to the computer program as the encrypted information (see figure 4, and see paragraph 0018.)

Applebaum does not teach installing the computer program by entering a biometric code, sending the biometric code to a server.

Brody teaches a method of personalizing published software (see Abstract), in which he teaches installing the computer program by entering a biometric code, sending the biometric code to a server (see figure 2, and see paragraph 147.)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Applebaum to include installing the computer program by entering a biometric code, sending the biometric code to a server.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Applebaum by the teaching of Brody, because installing the computer program by entering a biometric code, sending the biometric code to a server, would offer personalized installation of the software for remoter clients within a distributed network/system.

As to claim 4, Applebaum as modified, teaches wherein the encrypting uses a private key at the server (see Applebaum, paragraph 0042), and the decrypting verifies a signature of the private key (see Applebaum, paragraph 0052.)

As to claim 5, Applebaum as modified, teaches wherein the encrypting uses a private key at the server (see Applebaum, paragraph 0042), and the decrypting uses a public key included as a part of the computer program (see Applebaum, paragraph 0042, and see page 7, claim 20.)

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As to claim 6, Applebaum as modified, teaches the method further comprising determining if a biometric reader is attached to a port (see Applebaum, paragraph 0048), and wherein the program is only allowed to run if the biometric reader is attached to the port (see Applebaum, paragraph 0047.)

Response to Arguments

10. Applicant's arguments filed on 24-May-2004 with respect to the rejected claims in view of the cited references have been fully considered but they are not considered persuasive:

In response to the applicant's argument regarding Applebaum, that "nowhere is there any teaching or suggestion of a 'limited exception mode' without establishing that said personal information agrees with said decrypted information", the argument has been fully considered but is not deemed persuasive, because claim 7 does not indicate what exactly the software can do in a "limited exception mode" or whether this "limited exception mode" is related to the user whose identification information did not match the decrypted information. Claim 36 of the cited reference, Applebaum, teaches "restricting access to said distributed productivity environment if said personal information does not match said identification information." The examiner interprets that "restricting the user access" does not prevent "the software" from performing in a "limited exception mode" (e.g. "the limited exception mode" is

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the mode the software continues to run in, allowing other authorized distributed users to gain access to the system.)

In response to the applicant's arguments regarding Brody that "nowhere is there any teaching or suggestion of "obtaining this information as part of the installation routine", the arguments have been fully considered but are not deemed persuasive, because claim 8, in lines 4 and 5, recites: "obtaining a reference biometric information from an authorized user *at the time of installing the software*". Claim 8 does not specifically require that this "obtaining of information" is a "part of the installation routine" as stated in the applicant's arguments. Further, Brody teaches the "obtaining of information at the time of installing the software" in paragraph 92, where Brody states: "Generally, legitimate users obtain a license to use the software from the software publisher, and are thereby authorized users of such software." Hence, the authorized user has a license, which he can input during the "manual setup" (Brody, paragraph 82), which indicates that "providing this information by the user" (obtaining the information) is done "at the time of installing the software".

In addition, Brody, in figure 2 (admitted prior art), depicts the process of "obtaining the information" in blocks 208, 210, and 212, "at the time of installing the program" (block 214.)

In response to the applicant's argument regarding the "advantage over Brody" in that "claim 8 allows anyone to install the software. However, once installed, the software is matched with a reference biometric, and cannot later be used by anyone

who does not match the reference biometric”, the argument has been fully considered but is not deemed persuasive, because “allowing anyone to install the software” and “cannot later be used by anyone who does not match the reference biometric” are not recited in the rejected claim.

Claim 8 recites:

requesting a computer system to install a specified program;
determining whether said computer program is verified for
installation;
obtaining a reference biometric information from an authorized user
at the time of installing the software, responsive to said determining that
said computer program is verified for installation;
thereafter allowing said program to run normally only when biometric
information is obtained which matches said reference biometric
information.

Claim 8 does not teach the actual step of “installing” the program, as it jumps from “verifying the program for installation” to “allowing the program to run”. Therefore, the applicant’s argument that “claim 8 allows anyone to install the software” is not deemed persuasive. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

12. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Tony Mahmoudi whose telephone number is (703) 305-4887. The examiner can normally be reached on Mondays-Fridays from 08:00 am to 04:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici, can be reached at (703) 305-3830.

tm

September 17, 2004


SAM RIMELL
PRIMARY EXAMINER